

## **REMARKS**

Applicants reply to the Office Action mailed on July 29, 2005, within the shortened statutory period for reply. Claims 1-9 were pending and the Examiner rejects claims 1-9. In reply, Applicants amend claims 1-9, add claims 10-12 and address the Examiner's remarks. Support for the amendments may be found in the originally-filed specification, claims, and figures. No new matter has been introduced by these amendments. Reconsideration of this application is respectfully requested.

The Examiner advised Applicants that under 37 C.F.R. § 1.56, Applicants are obligated to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made. Applicants respectfully assert that the subject matter of the various claims was commonly owned at the time the inventions covered therein were made and therefore, Applicants have complied with 37 C.F.R. § 1.56.

## **DOUBLE PATENTING**

Claims 1-9 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 22-24, 26-29, and 33-34 of copending Application Nos. 10/710,310 and 10/710,311; over claims 23-30 and 33-34 of copending Application Nos. 10/710,315, 10/710,326, 10/710,328 and 10/710,329; over claims 22-24, 26-29, and 32-33 of copending Application Nos. 10/710,317, 10/710,323, 10/710,324, 10/710,325 and 10/710,327; over claims 24-26, 28-31, and 34-35 of copending Application No. 10/710,319; over claims 22-24, 26-29, and 33-34 of copending Application Nos. 10/708,825 and 10/708,826; over claims 24-26, 28-31, and 34-35 of copending Application No. 10/708,828; over claims 23-25, 27-30, and 33-34 of copending Application Nos. 10/708,827, 10/708,833, 10/708,835 and 10/708,836; and over claims 22-24, 26-29, and 32-33 of copending Application Nos. 10/708,828, 10/708,830, 10/708,831, 10/708,832 and 10/708,834.

Claims 1, 6, 7, and 9 are provisionally rejected as being unpatentable over claims 1, 8, 10, and 19 of copending Application No. 10/710,307; claims 1, 6, and 8 are provisionally rejected

over claims 1, 7, and 6 of copending Application No. 10/710,309; claims 1 and 6-9 are provisionally rejected over claims 1, 8, 10, 14, and 19 of copending Application No. 10/708,822; and claims 1 and 6 are provisionally rejected over claims 1 and 7 of copending Application No. 10/708,824.

While Applicants respectfully traverse these double patenting rejections, in the interest of compact prosecution, Applicants submit terminal disclaimers in compliance with 37 C.F.R. § 1.321(c). Applicants also assert that this non-statutory double patenting rejection is based on the above-listed applications which are all commonly owned with this application by assignee, American Express Travel Related Services Company, Inc.

### **35 U.S.C. § 102 REJECTIONS**

The Examiner rejects claims 1, 2, 4, 6, 8 and 9 under 35 U.S.C. § 102(e) as being anticipated by Black, U.S. Patent Application No. 2005/0122209 (“Black”). The Examiner notes that, “Re claim 1 Black teaches a method for facilitating biometric security in a smartcard transaction system comprising: proffering a biometric to a biometric sensor communicating with said system to initiate verification of a biometric sample for facilitating authorization of a transaction (abstract, FIG. 1 C).” (Page 7). Applicants respectfully traverse this rejection.

In general, Black discloses an identity authentication system comprising a device for capturing a customer signature. Black requires a user to provide an electronic signature using a stylus or other similar device ([0016], [0022]). Further, while Black discloses submitting personal data during the registration procedure (Fig. 5A), Black only discloses such personal data to be customer record numbers, customer bank account numbers, account balance, reference prints and reference signatures (Fig. 10A-B, 11A-B). Black is silent as to providing smartcard information, not because such information is obviously provided, but because Black does not enable both biometric registration and payment. Rather, Black merely provides *access* to a payment account “when the sensed digital signature matches a reference digital signature” ([0020]).

Further still, Black is limited to associating a single transaction account with the customer record (Figs. 10A-B, 11A-B, [0087]). That is, Black is limited to having a smartcard consisting of only one “customer account that is to be used for payment” ([0084]), and not a smartcard with

multiple credit and/or debit accounts. Thus, Black does not teach or disclose at least “initiating verification of said proffered biometric sample, wherein said proffered biometric sample is associated with at least two accounts, wherein each of said at least two accounts includes at least one of: a charge card account, a credit card account, a debit card account, a savings account, a private label account and a loyalty point account,” as recited in independent claim 1.

Claims 2, 4, 6, 8 and 9 indirectly and directly depend from claim 1 and contain all of the elements thereof. Therefore, Applicants respectfully submit that claims 2, 4, 6, 8 and 9 are differentiated from the cited references at least for the same reasons as set forth above, in addition to their own respective features. Accordingly, Applicants respectfully request withdrawal of the rejection of claims 2, 4, 6, 8 and 9.

### **35 U.S.C. § 103 REJECTION**

The Examiner rejects claims 3, 5 and 7 under 35 U.S.C. §103(a) as being unpatentable over Black. Applicants respectfully traverse this rejection.

As discussed above, Black is limited to associating a single transaction account with the customer record (Figs. 10A-B, 11A-B, [0087]). That is, Black is limited to having a smartcard consisting of only one “customer account that is to be used for payment” ([0084]), and not a smartcard with multiple credit and/or debit accounts. Thus, Black does not teach or let alone suggest at least “initiating verification of said proffered biometric sample, wherein said proffered biometric sample is associated with at least two accounts, wherein each of said at least two accounts includes at least one of: a charge card account, a credit card account,” as recited in independent claim 1.

Claims 3, 5 and 7 indirectly and directly depend from claim 1 and contain all of the elements thereof. Therefore, Applicants respectfully submit that claims 3, 5 and 7 are differentiated from the cited reference at least for the same reasons as set forth above, in addition to their own respective features. Accordingly, Applicants respectfully request withdrawal of the rejection of claims 3, 5 and 7.

### **NEW CLAIMS 10-12**

New claims 10-12 depend from claim 1 and contain all of the elements thereof. Therefore, Applicants assert that new claims 10-12 are differentiated from the cited references at least for the same reasons as set forth above, in addition to their own respective features.

## **CONCLUSION**

Applicants respectfully submit that the pending claims are in condition for allowance. No new matter is added in this Reply. Reconsideration of the application is thus requested. **The Commissioner is hereby authorized to charge any fees which may be required, or credit any overpayment, to Deposit Account No. 19-2814.** Applicants invite the Examiner to telephone the undersigned if the Examiner has any questions regarding this Reply or the application in general.

Respectfully submitted,

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